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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/803,928
Filing Date: March 13, 2001
Appellant(s): MOODIE ET AL.

MAILED

JUN 27 2005

Technology Center 2100

Kenyon & Kenyon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 2, 2005.

RD

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 27-38 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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6,101,483	Petrovich et al	8-2000
6,738,053	Borgstrom et al	5-2004
6,640,214	Nambudiri et al	10-2003

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 27-29, 31, 33, 34, 35 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,101,483 issued to Petrovich et al (hereafter Petrovich).

Claims 27 and 33:

Petrovich discloses a method of indicating whether items on a shopping list are located in the vicinity of a shopper [audible communication using speaker 88 of portable terminal 40, col 10, lines 39-62], the method comprising:

storing a shopping list in a portable computer device [memory 46, Fig 3B, col 4, lines 50-65], wherein the shopping list comprises a plurality of items:

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receiving a signal at the portable computer device from a short-range, local wireless communications system located in a store [wireless access point 18, Fig 1, col 4, lines 1-12, col 5, lines 9-22];

determining from the received signal at the portable computer device whether any item on the shopping list is available in the store, if any of the items on the shopping list are determined to be available in the store, providing an indication to a user of the portable computer device that the item is available in the store [optimized shopping list directs a shopper 58 along a path 104 through shelves 102 of the shopping establishment 14, col 10, lines 25-38, Fig 4].

Claims 28 and 34:

Petrovich discloses wherein the short-range, local wireless communication signal is sent from a location in the store that is within the vicinity of the portable computer device, and wherein the indication provided to a user indicates that the item is within the vicinity of the user [col 10, lines 39-62, Fig 4].

Claims 29 and 35:

Petrovich discloses wherein the portable computer device is a personal digital assistant [col 6, lines 37-53].

Claims 31 and 37:

Petrovich discloses wherein the step of storing a shopping list in the portable computer device comprises downloading the shopping list from the Internet at a location inside of the store [col 4, lines 1-12].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich in view of US Pat No 6,738,053 issued to Borgstrom et al (hereafter Borgstrom).

Claims 30 and 36:

Petrovich discloses the elements of claim 27 as noted above.

Furthermore, Petrovich discloses a short-range local wireless communications system [col 10, lines 10-62] but is silent regarding the Bluetooth communications standard. Borgstrom discloses the Bluetooth communications standard [Fig 11, 22]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Petrovich to include the Bluetooth communications standard as taught by Borgstrom for the purpose of providing a means of wirelessly connecting the PDA to the host computer in the shopping establishment. The ordinarily skilled artisan would have been motivated to improve the invention of Petrovich per the above for the purpose of providing a wireless portable device such that the shopper with his/her PDA can move between the shelves of the shopping establishment and select grocery items which are on a shopping list.

Claims 32 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich in view of US Pat No 6,640,214 issued to Nambudiri et al (hereafter Nambudiri).

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Claims 32 and 38:

Petrovich discloses the elements of claim 27 as noted above.

Petrovich fails to disclose wherein the step of entering a shopping list in the portable computer device comprises receiving a selection of a recipe from a user; determining a list of items based on the ingredients specified in the recipe, and storing the list of items on the portable computer device. Nambudiri discloses wherein the step of entering a shopping list in the portable computer device comprises receiving a selection of a recipe from a user; determining a list of items based on the ingredients specified in the recipe, and storing the list of items on the portable computer device [col 12, lines 35-52]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Petrovich to include wherein the step of entering a shopping list in the portable computer device comprises receiving a selection of a recipe from a user; determining a list of items based on the ingredients specified in the recipe, and storing the list of items on the portable computer device as taught by Nambudiri for the purpose of providing an electronic means of purchasing the items from a shopping establishment which is geared to automated purchasing. The ordinarily skilled artisan would have been motivated to improve the invention of Petrovich per the above such that the shopper does not have to produce a hand written list of the ingredients which is subject to user error.

Response to Arguments

Appellant's arguments filed in Appeal Brief of 4/2/2005 have been fully considered but they are not persuasive.

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Appellant Argues:

Appellant states in the fourth paragraph on page 3 "Claims 27-29, 31, 33-35 and 37 were rejected under 35 U.S.C. § 102 as anticipated by Petrovich. This rejection is not proper because Petrovich does not disclose each and every element of the claim, as is required for an anticipation rejection. See MPEP § 2131. In particular, Petrovich does not disclose a method that determines 'whether any item on the shopping list is available' or that 'provide[s] an indication to the user of the portable computer device that the item is available,' as recited respectfully in claims 27 and 33 (emphasis added)."

Examiner Responds:

Examiner is not persuaded for the reasons given below.

MPEP § 716.01(d) states:

When an applicant >timely< submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the prima facie case. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Examiner is not convinced that instant application is patentable, contrarily, the preponderance of evidence supports above prima facie case of anticipation by Petrovich.

Regarding the persuasiveness of appellant's arguments, appellant's arguments are limited to the claim limitation "determining from the received signal at the portable computer device whether any item on the shopping list is available in the store."

Petrovich discloses, as considered below in greater detail, many instances of comparing the user-entered shopping list with the computer-generated database in the shopping establishment, verifying the correctness and validity of the user-entered shopping list, printing out an optimized shopping list in the shopping establishment, updating the electronic list in the memory of the portable terminal when the portable terminal is in the shopping establishment, and providing a reoptimized shopping list in the shopping establishment. Appellant fails to address above disclosure(s) by Petrovich and thus appellant fails to point out how and why instant invention is not anticipated by the cited prior art. Examiner notes Rule 37CFR 1.111(b) requires appellant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of appellant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

Appellant states in the fifth paragraph on page 3 and the first paragraph on page 4 that Petrovich is completely silent regarding "what message is communicated if the item is not available." Appellant is in error because above language is not included in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner has duly considered the persuasiveness of Appellant's arguments. Appellant's arguments are not convincing and therefore, maintaining above prima facie rejection of anticipation by Petrovich is justified.

Inherent Disclosure:

An in-depth analysis of the case for anticipation by Petrovich of the claim limitation "determining from the received signal at the portable computer device whether any item on the

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shopping list is available in the store” is per the following. Examiner acknowledges that the claim language “available in the store” is not included in the disclosure of Petrovich.

Nevertheless, the following disclosure(s) by Petrovich teach that an item on the shopping list is *inherently* available in the store. Regarding inherency, MPEP § 2112 [R-2] states:

Requirements of Rejection Based on Inherency; Burden of Proof

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

Inherent is defined as existing in someone or something as a natural and inseparable quality, characteristic, or right.¹ Examiner demonstrates below that “any item on the shopping list [being] available in the store” is a natural and inseparable quality per the following disclosures by Petrovich.

Petrovich inherently discloses:

Petrovich discloses the following in column 2, lines 25-35:

The shopping establishment cradle accepts the data associated with the bar codes from the portable terminal through the kiosk data interface and the terminal two-way data interface when the portable terminal is received in the kiosk portable terminal-receiving station, and then downloads the data associated with the bar codes to the host computer.

Petrovich discloses a shopper enters a shopping list via bar codes in the shopper's home and then down-loads the shopping list to host computer 16 in the store. It is inherent in above disclosure that the host computer 16 compares the user-entered shopping list with inventory

¹ Webster's New World College Dictionary, Fourth Edition.

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available in the store such that when the shopper proceeds to the store, the shopper can be confident that the items which he/she has entered in advance from home are ready and available on the shelves in the store. If the above is not inherent in the disclosure of Petrovich, then preparing a shopping-list by entering bar-codes in the shopper's home would be pointless.

Petrovich inherently discloses:

Consider the following disclosure by Petrovich in column 9, lines 12-19:

When portable terminal 40 is used in the home 12, and the data associated with the bar codes is transferred to the data interface 34 of the home portable terminal-receiving station 32, host computer 16 can send at least one verification query to home cradle 30 in order to verify at least one of correctness and validity of an order which is based on the shopping list database.

Petrovich discloses above that after the shopper has entered a shopping list in his/her home, the host computer 16 located in the store can send at least one verification query regarding the shopping list. Verification, implies an item entered by the shopper is available for purchase. The shopper would be very frustrated if after entering the shopping list and receiving a confirmation by the host computer 16, the shopper proceeds to the store only to find that the item is not available. This is unreasonable and is contrary to good business practice. Furthermore, the claim language is very broad and general, i.e., "determining from the received signal at the portable computer device whether any item on the shopping list is available in the store." Appellant claims a single item. Examiner admits that it is possible that after verification by the host computer 16 in the store, the shopper proceeds to the store and indeed may find that a particular item previously entered by the shopper and confirmed by host computer 16 is not available in the store. However, it is unreasonable to assume that not a single item previously

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entered by the shopper and confirmed by host computer 16 in the store is not available in the store. The disclosure of a verification query by Petrovich, inherently discloses that the item is available in the store.

Petrovich inherently discloses:

Petrovich discloses in column 11, lines 19-25 the following:

The aforementioned verification queries can include, for example, final price and confirmation of the user's order including price, delivery or pick-up, and desired time. While this information can be sent by voice to telephone 100, it can instead be sent in written form to display 72 of portable terminal 40, or to separate home computer 68, in order to save time for the user. In an alternative embodiment, voice confirmation of a customer's order sections, order instructions, charge information and totals are provided in a system employing standard DTMF signals, e.g., 16 DTMF signals, to communicated with the store host to place the order. The system may also be used to provide prizes in order to promoted the use of the system, i.e., interactive trivia associated with product discounts.

Petrovich's disclosure of verification of an user's order including price, delivery or pickup, and desired time inherently discloses that the item is available in the store. In particular, the transmission of final price by the host computer 16 to shopper's portable terminal/home computer inherently discloses that items entered by the shopper are available in the store.

Petrovich inherently discloses:

Petrovich discloses in column 12, lines 16-16-27 the following:

In the item-by-item mode, the host computer 16 can respond to each item with a digitized voice setting forth the quantity of the item to be ordered and its description and size, and can then prompt the user to, for example, push the pound sign (on the telephone keypad) to confirm or the star sign to enter another number. This can be repeated until the entire shopping list is downloaded to host computer 16. Further, host computer 16 can also prompt the user to enter the desired delivery time, complete a survey, and the like via the key pad of telephone 100. This interaction could also instead be carried out using the display 72 of portable terminal 40 or using the home computer 68.

Petrovich discloses that the host computer 16 responds item by item to the entry by the shopper. Petrovich inherently discloses via the above response confirming details of the item that the item is available in the store.

Petrovich specifically discloses:

Now turning from inherent disclosure by Petrovich to direct disclosure by Petrovich that the item is available in the store, consider the following disclosure by Petrovich in column 9, line 55 through column 10, line 3:

Method steps associated with use of portable terminal 40 in shopping establishment 14 will now be described. It is to be appreciated that when portable terminal 40 is used in shopping establishment 14, data associated with the bar codes scanned in the home 12 of the user is transferred to the data interface 28 of the kiosk portable terminal-receiving station 26. With reference to FIG. 6, the method can include the additional step of printing a hard copy shopping list 98 from the kiosk cradle 24, for example with printer 96, in response to the data associated with the bar codes which were read in the home 12. It will be appreciated that a user of the system can simply check off data items listed on the hard copy shopping list with a conventional ink pen as the items are picked up off the shelves 102 (see FIG. 4) of the shopping establishment 14 and scanned with the portable terminal 40.

Petrovich discloses per the above that the shopper may print out a revised shopping list in the store per the items which are available in the store. The shopper then proceeds to pick up the items off the shelves in the store. After selection of the item, the shopper scans the item and thus immediately updates the inventory control system of the store and also prepares his/her list of selected items which can be presented at the check-out for payment. The above disclosure specifically teaches that the shopper obtains in the store, a hard-copy list of items available in the store and thus Petrovich anticipates the claim limitation “determining [...] whether any item on the shopping list is available in the store.” Examiner admits that above disclosure concerns a

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hard-copy printout, however, below Petrovich discloses an electronic list which is down-loaded to the portable terminal.

Petrovich specifically discloses:

Petrovich discloses the following in column 10, lines 25- 38:

Either the hard copy or electronic shopping list can be produced as an optimized shopping list in response to the shopping list database and information contained in the host computer 16 about location of the items within the shopping establishment 14. The optimized shopping list can be ordered to direct the user through the shopping establishment 14 in an efficient path. For example, with reference to FIG. 4, user 58 can be directed along the path 104 symbolized by dashed lines so as to move sequentially through shelves 102 of establishment 14. Items on the shopping list can be printed out in an order in which they will be encountered when user 58 travels efficient path 104. The optimized.

Petrovich discloses that the electronic list operates in the same manner as the hard-copy shopping list, i.e., the shopper down-loads a revised shopping list in the store to his/her portable handheld device. The shopper then proceeds to pick up the items off the shelves in the same manner as with the hard-copy. The above disclosure by Petrovich anticipates the claim limitation "determining from the received signal at the portable computer device whether any item on the shopping list is available in the store."

Petrovich specifically discloses:

Petrovich discloses the following in column 10, lines 39-59:

To further enhance the efficiency of the user's shopping experience, the method can include the additional step of sensing the location of the portable terminal 40 with the position-sensing module 90. This position presumably corresponds to the position of user 58 within the shopping establishment 14. In this case, the method can include the additional step of communicating a message advising the user 58 when the user 58 has deviated from the efficient path 104. This message could be generated by wireless communication from host computer 16 to portable terminal 40, or could be generated otherwise; for example, within terminal 40 in response to

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downloaded information regarding location of goods. Still referring to FIG. 4, when user 58 embarks upon an inefficient path 106, symbolized by dash-dotted lines, a message can be sent to the user 58 to indicate that he or she should traverse the one of the shelves 102 which would have been missed in taking inefficient path 106. More preferably, the list can be reoptimized with new directions based on the user's new location. The communicating step can optionally include an audible communication using speaker 88 of portable terminal 40. One of the previously-discussed keys on portable terminal 40 can be programmed as an interactive marketing help key to alert shopping establishment personnel to the customer's location.

Petrovich discloses per the above, that the user receives an audible communication via his/her handheld device to indicate that the shopper has deviated from the efficient path and that items will thus no longer be encountered per the optimized list which was downloaded in the store. The disclosure by Petrovich of an audible communication from the shopper's portable terminal and the reoptimized list on the shopper's portable terminal anticipates the claim limitation "determining from the received signal at the portable computer device whether any item on the shopping list is available in the store."

Petrovich specifically discloses:

Petrovich discloses in column 12, lines 45-48 the following:

When the position-sensing module is employed, the message sent to the user could be as specific as prompting the user to go back to a given shelf and to remind them which product on that shelf they forgot to purchase.

Petrovich's disclosure that an item is available on a shelf in the store specifically reads on the claim limitation "determining from the received signal at the portable computer device whether any item on the shopping list is available in the store."

Appellant Argues:

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Appellant states in the fourth paragraph on page 5 “Claims 30 and 36 depend from one of claims 27 and 33. As discussed above, Petrovich fails to teach or suggest determining whether an item is available in the store or providing an indication to the user that the item is available in the store as recited in claims 27 and 33. These deficiencies of Petrovich are not corrected by Borgstrom because Borgstrom also fails to teach or suggest determining whether an item is available in the store or providing an indication to the user that the item is available in the store as recited in claims 27 and 33.

Examiner Responds:

Examiner is not persuaded. Appellant is referred to above response by examiner which demonstrates that Petrovich, inherently and specifically discloses the claim limitation “determining from the received signal at the portable computer device whether any item on the shopping list is available in the store.

Appellant Argues:

Appellant states in the fifth paragraph on page 5 “Moreover, even if an ordinary person of ordinary skill in the art were to combine Petrovich and Borgstrom, there is no evidence of a motivation to modify such a combined device as would be required to provide Appellant’s claimed invention.

Appellant continues in the fifth paragraph on page 5 “Here, even if Petrovich and Borgstrom were combined, there is no evidence of record which would teach or suggest to a person of ordinary skill in the art a step of determining whether an item is available in the store

or of providing an indication to the user that the item is available in the store as recited in claims 27 and 33.

Examiner Responds:

Examiner is not persuaded. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, Appellant is referred to above responses by examiner regarding Petrovich's teaching that an item is available in the store.

Appellant Argues:

Appellant states in the second paragraph on page 6 "Claims 32 and 38 depend from one of claims 27 and 33. As stated previously, Petrovich fails to teach or suggest determining whether an item is available in the store or providing an indication to the user that the item is available in the store, as recited in claims 27 and 33. These deficiencies of Petrovich are not corrected by Nambudiri. Nambudiri discloses generating a list of ingredients in a recipe and storing the list in a portable terminal. [....] However, Nambudiri does not teach or suggest determining whether an item is available in the store or providing an indication to the user that the item is available in the store as recited in claims 27 and 33. Therefore, combining Nambudiri with Petrovich would still not provide Appellant's claimed invention.

Examiner Responds:

Examiner is not persuaded. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the

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rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant is referred to above response by examiner which demonstrates that Petrovich, inherently and specifically discloses the claim limitation "determining from the received signal at the portable computer device whether any item on the shopping list is available in the store.

Summary:

Examiner has above considered the patentability of the claimed invention. The ultimate determination per MPEP § 716.01(d) must be based on the preponderance of evidence of the entire record and the persuasiveness of appellant's arguments. The preponderance of evidence and non-persuasive arguments by appellant justifies above prima facie rejection of anticipation by Petrovich.

For the above reasons, it is believed that the rejections should be sustained.

An Appeal Conference was held on June 15, 2005, with Safet Metjahic, Hosain Alam and Etienne LeRoux in attendance.

Respectfully submitted,



Safet Metjahic

SPE

AU 2161



Hosain Alam

SPE

AU 2166



Etienne LeRoux

AU 2161